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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/330,651	06/11/1999	CONNIE T. MARSHALL	ODS-5	9681

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EXAMINER

CHRISTMAN, KATHLEEN M

ART UNIT	PAPER NUMBER
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3713

DATE MAILED: 07/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/330,651

Applicant(s)

MARSHALL ET AL.

Examiner

Kathleen M Christman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7-13, 15-20, 22-28 and 30-44 is/are pending in the application.
- 4a) Of the above claim(s) 1-4, 10-13, 15-19, 25-28 and 30-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5, 7-9, 20, 22-24 and 35-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 04122004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

In response to the amendment and request for continued examination filed 04/12/2004, claims 1-4, 10-13, 15-19, 25-28, and 30-34 remain withdrawn from consideration; claims 6, 14, 21, and 29 have been previously cancelled; claims 5, 7-9, 20, 22-24 and newly added claims 35-44 are pending.

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 04/12/2004 has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 5, 7-9 and 35-39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Regarding claim 5, the claimed method recites the steps of "receiving user inputs" and "displaying a wager input interface ...". The claim further recites that "the plurality of selectable options for a subsequent one of the wager requirements depends on a selection of one of the plurality of selectable options for a previous one of the wager requirements", however the claim fails to recite how the a selection of a previous wager requirement is made, whether it is made by the user, or the computer and when it is made. As such it is unclear how exactly the combination of steps inter-relate so as to allow for "interactive wagering on horse races". Although claim 7, recites that the user inputs are used to select

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the selectable options, it still fails to show how, within the method this is achieved. As currently claimed the method accepts a user inputs (which in claim 7 are used to select selectable options) and then displays a user interface where the selectable options are presented. It is unclear how the user is to make these selections prior to even being presented with the selectable options. Claims 8, 9, and 35-39 do not serve to clarify this point and are thus rejected for the same reasons.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
3. Claims 5, 7-9, 20, 22-24 and 35-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Mir et al (US 6450887 B1) and WO/9709699 (hereinafter '699) further in view of Beaudet et al (US 5559945). Mir et al teaches a method which includes displaying a wager input interface for creating a wager on a horse race having a plurality of wager requirement and a plurality of selectable options for each of the wager requirements, wherein the wager requirements are displayed so that each wager requirement is substantially aligned in a first dimension, and wherein the plurality of selectable options for each of the plurality of wager requirements is substantially aligned in a second dimension with each corresponding one of the plurality of wager requirements. See Figure 4, where the

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"\$" symbol and "Pool" represent the wager requirements and "\$1", "\$2", etc. and "Win", "Place", "Show", etc. represent the selectable options associate with the requirements. Mir et al clearly shows that the wager requirements in this format include a wager type selection, and an amount selection. Receiving user inputs and using these inputs to select on of the plurality of selectable options for each of the plurality of wager requirements, as in claims 7 and 22, are inherent features. Mir et al teaches that the user selects the track and race prior to selecting a wager type (claims 37 and 42), in col. 9: 28-32.

Mir et al fails to particularly teach that the wager requirements arranged in this manner include a track selection, a race selection, and a horse selection (claims 5 and 20); that a selected option is highlighted (claims 8 and 23); a ticket window that indicates each of the plurality of options selected (claims 9 and 24); and that the plurality of selectable options for a subsequent one of the wager requirements depends on a selection of the plurality of selectable options for a previous one of the wager requirements (claims 5 and 20). Regarding claims 35, 36, 38-41, 43 and 44, although Mir et al teaches that each of the inputs are required, the specific orders are not clearly shown.

'699 teaches a system and method for interactive wagering that includes the user selection requirements of track selection, race selection, wager type selection, horse selection, and amount selection in figures 35-38, user inputs being used to select at least one of the plurality of options for each of the user selection requirements (claims 7 and 22) also in the above figures, the selected option being highlighted (claims 8 and 23) on page 25 line 21+ and a ticket window that indicates each of the plurality of options selected (claims 9 and 24) in figure 39. '699 teaches that the user selects the race track, and then a race for that track where the race options are dependent on the track selected (claims 35 and 40) in Figures 9 and 10. The user selects a race option followed by a wager amount (claims 36 and 41), in figures 11 and 12. The horses available for a user to select is in a wager is inherently dependent upon the race that is selected by the user, as recited in claims 38 and 43. The horse selection being dependent upon the wager type selection (claims 39 and 44) is shown in figures 37 and 38. As such the '699 reference teaches all of the claimed wager requirements dependencies either explicitly or inherently. As such the '69 reference teaches the more general limitation that the subsequent plurality of wager

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requirements depends on a selection of one of the plurality of selectable options for a previous one of the wager requirements, as in claims 5 and 20.

'699 does not teach the specific lay out including all the wagering requirements as claimed by applicant but does show the general "concept" of the layout in Figure 46. Mir et al discloses this layout in Figure 4 as described above.

Beaudet et al (US 5559945) teaches a multiple level selection system in which multiple options are presented in a manner similar to that claimed, see Figure 1. Further Beaudet et al teaches a selection interface in which the options at one level are influenced by the selected options of a previous level, see col. 1: 49-55 and col. 2: 49- col. 3: 10.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate all wager requirements into a single screen in the format taught by Mir et al with the dependencies as taught by the '699 reference so as to provide a simple interface for the user that is presented so as to increase the user's comprehension and comfort in passing through the levels of selection as taught by Beaudet et al.

Response to Arguments

4. In view of applicant's arguments, see pages 19-21 of the response filed 04/12/2004, and the amendments made to claims 5 and 20 the previous rejection under 35 USC §103 as being obvious in view of Mir et al and the '699 reference have been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Beaudet et al.

Conclusion

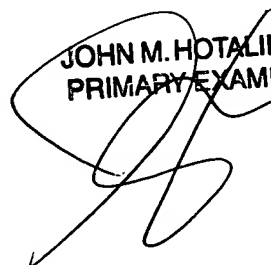
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathleen M Christman whose telephone number is (703) 308-6374. The examiner can normally be reached on M-F 7:30-5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on (703) 308-1745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kathleen M. Christman


JOHN M. HOTALING, II
PRIMARY EXAMINER